

REMARKS

Claims 1 through 18 remain pending in this application. The Amendment proposed for entry herein cancels claims 16 through 18 in response to the final Office Action dated May 21, 2003. Entry of the Amendment and favorable reconsideration of the application in light of the following comments are respectfully solicited.

It is noted that the Office Action has not considered three prior art documents submitted in an Information Disclosure Statement filed April 8, 2003 as stated at paragraph 4. As the copy of the submitted form PTO-1449 attached to the Office Action indicates "no copy," apparently the submitted copies became separated from the file and lost after filing. Submitted herewith is an additional copy of each of these references with a new form PTO-1449 and a copy of the PTO receipt indicating filing of the references. The three missing references were first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the April 8 Information Disclosure Statement as described in 37 CFR 1.97(e)(1). A copy of the foreign search report or office action, together with an English language version thereof was submitted with the earlier Information Disclosure Statement.

Consideration of the submitted references is respectfully solicited.

Paragraph 3 of the Office Action holds that the declaration, filed under 37 CFR 1.131 to eliminate the Hsu '648 patent (hereinafter referred to as "Hsu") as a prior art reference, is ineffective because Hsu claims the same invention as the claims in this application. According to the Office Action, the patent can be overcome only through an Interference proceeding in which priority of invention must be established.

The controlling rule to be applied for determination of whether claims are appropriate for interference proceedings is 37 CFR 1.601(n). This section is reproduced as follows:

(n) Invention "A" is the *same patentable invention* as an invention "B" when invention "A" is the same as (35 U.S.C. § 102) or is obvious (35 U.S.C. § 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A." Invention "A" is a *separate patentable invention* with respect to invention "B" when invention "A" is new (35 U.S.C. § 102) and non-obvious (35 U.S.C. § 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A" (emphasis in original).

The test to be applied, therefore, is whether claims of both the patent and application are identical to each other or, if not, whether claims of both the patent and application are not patentably distinct from each other. "Not patentably distinct from each other" means that a claim of the present invention would be obvious from a claim of the patent. This test has not been met.

The Office Action has not identified which claims of Hsu are considered by the Examiner to be the same invention as claims of the present application, which also have not been identified; no detailed comparison between the Hsu claims and the claims of the present application has been set forth in the Office Action. It is well settled that the initial burden of establishing a basis for denying patentability to a claimed invention rests upon the Examiner. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In failing to support the conclusion that Hsu and the present application claims the same invention, the Office Action falls far short of this burden and has denied applicant procedural due process.

Moreover, it is submitted that the stated conclusion is in error. Independent claim 1 and its dependent claims 2 through 15 do not recite the same invention as recited in the claims of Hsu. Upon reading the claims of Hsu, it is immediately clear that none of the patent claims is identical to any of the claims of the present application. For example, claim 1 of Hsu (from which all remaining claims depend) differs from the claims of the present application in at least the following respects:

Claim 1 of Hsu recites "said inner stator portion also having wire grooves to receive a plurality of stator coils." None of the claims of the present application recites wire grooves in the stator and no such arrangement has been disclosed in the present application. In fact, claim 1 of the present application, from which all remaining claims depend, expressly requires that the stator comprise "a plurality of ferromagnetic core segments ferromagnetically isolated from each other" and "each of the core segments having respective coils wound thereon to form stator windings."

Hsu discloses and claims a single inner stator portion. Claim 1 of the present application is a "separate patentable invention" from claim 1 of Hsu because the required core segments are non-obvious from claim 1 of Hsu, as recognized at page 6 of the Office Action.

Claim 1 of Hsu recites "said switch circuit board being locked at one side of said end cover plates." None of the application claims recites Hsu's specifically claimed arrangement.

Claim 1 of Hsu recites " said supporting shaft having more than one through holes" a requirement that is not recited in the claims of the present application and would not have been obvious from the claims of the present invention.

It is submitted, therefore, that no cause for interference proceedings has been established by the Office Action and that the declaration, filed under 37 CFR 1.131 in the response of April 8, 2003, is effective to eliminate the Hsu '648 patent as a prior art reference. Therefore, the following rejections are traversed and withdrawal thereof is solicited: the rejection of claims 1, 2, 8, 13 and 15 under 35 U.S.C. § 103(a) as being unpatentable over the '648 patent in view of Artus, at paragraph 11 of the Office Action; the rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over the '648 patent in view of Artus and Isaak, at paragraph 12 of the Office Action; the rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over the '648 patent in view of Artus, Isaak and Erdman, at paragraph 13 of the Office Action; the rejection of

claims 5 through 7 under 35 U.S.C. § 103(a) as being unpatentable over the '648 patent in view of Artus and Eakman, at paragraph 14 of the Office Action; the rejection of claims 10 through 12 under 35 U.S.C. § 103(a) as being unpatentable over the '648 patent in view of Artus, Isaak and Fatula, at paragraph 15 of the Office Action; the rejection of claims 14 and 9 under 35 U.S.C. § 103(a) as being unpatentable over the '648 patent in view of Artus and Erdman, at paragraph 16 of the Office Action; and the rejection of claim 18 under 35 U.S.C. § 103(a) as being unpatentable over the '648 patent in view of Isaak, at paragraph 17 of the Office Action.

The rejections of claims 16 and 17 at paragraphs 5 and 6 of the Office Action are now moot as these claims now have been cancelled.

Claim 1 has been further rejected under 35 U.S.C. § 103(a) as being unpatentable over De Filippis in view of U.S. patent 4,303,843 (Arnoux). The Office Action recognizes that De Filippis does not disclose a plurality of ferromagnetic core segments ferromagnetically isolated from each other. Arnoux is relied upon for such teaching to conclude that it would have been obvious to modify the disclosed De Filippis structure to provide such feature.

The rejection is respectfully traversed. Under well established legal precedents, it is incumbent upon the Examiner to factually support a conclusion of obviousness under 35 U.S.C. § 103. *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). As stated in *Graham v. John Deere Co.* 383 U.S. 1, 13, 148 USPQ 459, 465 (1966), obviousness under 35 U.S.C. §103 must be determined by considering (1) the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; and (3) resolving the level of ordinary skill in the pertinent art. The PTO is thus charged with the initial burden of identifying a source in the applied prior art for the realistic requisite motivation for combining applied references to arrive at the claimed

invention with a reasonable expectation of successfully achieving a specific benefit. *Smith Industries Medical Systems v. Vital Signs*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999).

The Examiner must provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). It should be recognized that, even if the prior art *could* be modified so as to result in the combination defined by the claims, the modification would not have been obvious unless the prior art suggested the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). In the absence of such a prior art suggestion for modification of the references, the basis of the rejection is no more than inappropriate hindsight reconstruction using appellant's claims as a guide. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). The requisite motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103 is not an abstract concept, but must stem from the applied prior art as a whole and have realistically impelled one having ordinary skill in the art, at the time the invention was made, to modify a reference in a specific manner to arrive at a specifically claimed invention with a reasonable expectation of achieving a specific benefit. *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). It is submitted that the examiner has not discharged the burden of establishing obviousness.

Arnoux discloses a magnetic flywheel driven by a centrifugal clutch to generate electricity. The Arnoux device is not a motor. There has been no rationale presented by the Office Action as to why a person of ordinary skill in the art would have been motivated to

modify the structure of De Filippis in light of the Arnoux disclosure. Moreover, it is submitted that modification of the De Filippis stator structure by dividing it into separate sections would destroy De Fillipis' intended feature of providing transformer portions within the stator core. Such possibility would have led the artisan away from the modification proposed by the Office Action.

In summary, it is submitted that all rejections of record have been overcome. Allowance of the application is respectfully solicited.